

30. (Previously Presented) A method of manufacturing a granulated foam control composition according to Claim 23, wherein the mixture of polyol esters containing carboxylate groups of different chain length is selected from a mixture of glyceryl tristearate and glyceryl tripalmitate, a mixture of glyceryl tristearate and glycerol triesters of saturated carboxylic acids having 20 or 22 carbon atoms, or ethylene glycol distearate and glycerol triesters of saturated carboxylic acids having 20 or 22 carbon atoms.

## REMARKS

### *Claim Rejections – 35 USC § 112*

The Examiner rejected Claims 1, 3-4, 10-11, 15-17, 19, 23, and 27-30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention. The Examiner states that in Claim 1 (line 10 from bottom) and Claim 23 (line 10 from bottom), “which are esterified by carboxylate groups” causes confusion because carboxylate groups are ester groups, *per se*, and cannot be further esterified.

Applicants have deleted the phrase “which are esterified by carboxylate groups” from Claims 1 and 23. Support for this amendment is found in paragraph 20 (alternatively page 7, lines 20-30) of Applicants’ specification. Therefore, the applicants believe that Claims 1 and 23, as amended, do in fact particularly point out and distinctly claim the subject matter that they regard as their invention. Therefore, the applicants request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1, 3-4, 10-11, 15-17, 19, 23, and 27-30 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner states that in Claim 1 (line 6), the Examiner is not able to find “fatty acids having 8 to 32 carbon atoms”.

Applicants have amended Claims 1 and 23 to recite “fatty acids having 8 to 36 carbon atoms”. Support for this amendment is found in paragraph 25 (at page 9, lines 18-20) of Applicants’ specification. Therefore, the applicants believe that Claims 1 and 23, as amended, do in fact contain subject matter which was described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, the applicants request that the rejection under 35 U.S.C. §112, first paragraph, be withdrawn and the claims allowed to issue.

***Claim Rejections – 35 USC § 102 and 103***

The rejection of Claims 1, 3-4, 10-11, 15-17, 19, 23, and 27-30 under 35 U.S.C. §102(a) as being anticipated by Dickinson (GB 1 523957) by the Examiner is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 20080329. The Examiner states that Applicants arguments have been fully considered but were not found persuasive. The Examiner states that the instant rejection will be removed when the rejections under 35 U.S.C. 112 are properly overcome.

Applicants believe the rejections under 35 U.S.C. 112 above have been properly overcome by Applicants. Therefore, the applicants request that the rejection under 35 U.S.C. §102(a) be withdrawn and the claims allowed to issue.

***Claim Rejections – 35 USC § 102 and 103***

The Examiner has rejected Claims 1, 3-4, 10-11, 15-17, 19, 27, and 29 under 35 U.S.C. 103(a) as being unpatentable over Schmid (U.S. Patent No. 6,610,752) in view of L’Hostis (EP1075863). The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize L’Hostis polyorganosiloxane in Schmid’s composition with expected success. Especially since L’Hostis is in the same field as that of

Schmid's endeavor. The Examiner also states that Schmid teaches depositing the polydiorganosiloxane, polyol ester, etc., in aqueous liquid form onto the particular carrier, and that the water is eventually removed. The Examiner therefore argues that the prior art's granulated foam control composition is the same as the claimed granulated foam control composition where the polydiorganosiloxane, polyol ester, etc. is used in non-aqueous liquid form.

The Examiner then states that the Affidavit filed by Applicants is not persuasive because it is not commensurate with the scope of at least Claim1. The Examiner argues that the affidavit made a comparison between the composition according to the present invention and that based on the disclosure of Schmid alone. The Examiner's position is that the composition of the present invention should have adequately been compared against the disclosure of Schmid where Schmid's polydiorganosiloxane fluid is replaced with L'Hostis polydiorganosiloxane fluid.

First, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness MPEP §2145 (X) (D). It is improper to combine references where the references teach away from their combination (MPEP §2145 (X) (D)). If the examiner believes there is factual support for rejecting the claimed invention under 35 U.S.C. §103, the examiner **must** then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant MPEP §2142.

Furthermore, by the Examiner's own admission, Schmid does not disclose that a mixture of foam control agent (i) and additive composition (ii) are deposited onto the particulate carrier in "non-aqueous liquid form" as currently claimed in independent claims 1 and 23. In fact, Schmid teaches away from depositing a mixture of foam control agent (i) and additive composition (ii) by teaching that their foam control agent and polyol ester are deposited in aqueous liquid form (i.e. in the form of an emulsion) as admitted above by the Examiner.

Second, Applicants disagree with the Examiner's statements above. First, the Examiner states the composition of the present invention should have adequately been compared against the disclosure of Schmid where Schmid's polydiorganosiloxane fluid is replaced with L'Hostis polydiorganosiloxane fluid. The Examiner is directed to page 2 of Applicants' Affidavit. In both the Invention of SN132 and the Comparison Example Prepared According to the Teachings of Schmid et al., the same foam control agent was used, namely silicone foam control agent FC1. Thus there was in fact an apples to apples comparison of the instant invention versus the disclosure of Schmid et al. Therefore since the same silicone foam control agent (FC1) was used in the comparison between the instant invention and Schmid et al., Applicants believe that the Affidavit was in fact commensurate with the scope of the Claims as drafted. Furthermore, it is Applicants' position that even if Schmid and L'Hostis are combined the instant invention is not arrived at and this renders the argument made the Examiner moot.

Furthermore, Applicants tested against the "closest single prior art reference cited by the Examiner". An Applicant is only required to compare his invention to the closest prior art (see *In re Baxter Trevenol Labs.*, 952 F. 2d 388, 392, 21 U.S.P.Q. 2d 1281, 1285 (Fed. Cir. 1991); *In re Holladay*, 584 F. 2d 384, 386, 199 U.S.P.Q. 516, 518 (C.C.P.A. 1978); and *In re Merchant*, 575 F.2d 865, 869, 197 U.S.P.Q. 785, 788 (C.C.P.A. 1978).

"Given the enormous variety of technologies and claimed subject matter, no all-encompassing principle or test can be delineated for determining the closest prior art. However, an almost self-evident guideline would appear effective in most cases. A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim

limitations in common with each reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield *the closest single prior art reference* (emphasis added).” *In re Merchant*, 575 F. 2d at 868, 197. Generally, an applicant need not test compounds taught in each and every reference. See *In re Payne*, 606 F.2d at 316, 203 U.S.P.Q. at 256. Applicants are not required to test the invention against the invention.

Applicants believe they tested against the embodiment that is closest to the present invention. In the 132 Affidavit the inventors ran a comparison test, comparing the performance in a powdered detergent formulation of a granulated foam control composition where the foam control agent was mixed with an additive composition and then deposited onto a particulate carrier (a composition as instantly claimed) versus a composition where a granulated foam control composition was emulsified, and then the foam control composition and additive composition were separately deposited onto a particulate carrier (i.e. a granulated foam control composition prepared according to the teachings of Schmid). It is clear from the results in the attached 132 Affidavit that the compositions of the instant invention produced far less foam than the composition prepared according to the teachings of Schmid.

It is the opinion of Applicants that the Examiner has not established a Prima Facie case of obviousness, however, in the event that the Examiner maintains this position, it is clear from the attached Affidavit that Applicants have successfully rebutted any prima facie case of obviousness established by the Examiner.

Applicants believe that the rejection under 35 U.S.C. §103(a) has been overcome. Therefore Applicants respectfully request that this rejection be removed by the Examiner and the Claims allowed to issue.

The Applicants hereby petition for a one (1) month extension of time to reply to the instant office action. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,  
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